

REMARKS

The Examiner is thanked for the due consideration given the application.

Claims 20-30 and 33-35 are pending in the application. Claims 20 and 30 have been amended to improve the language.

No new matter is believed to be added to the application by this amendment.

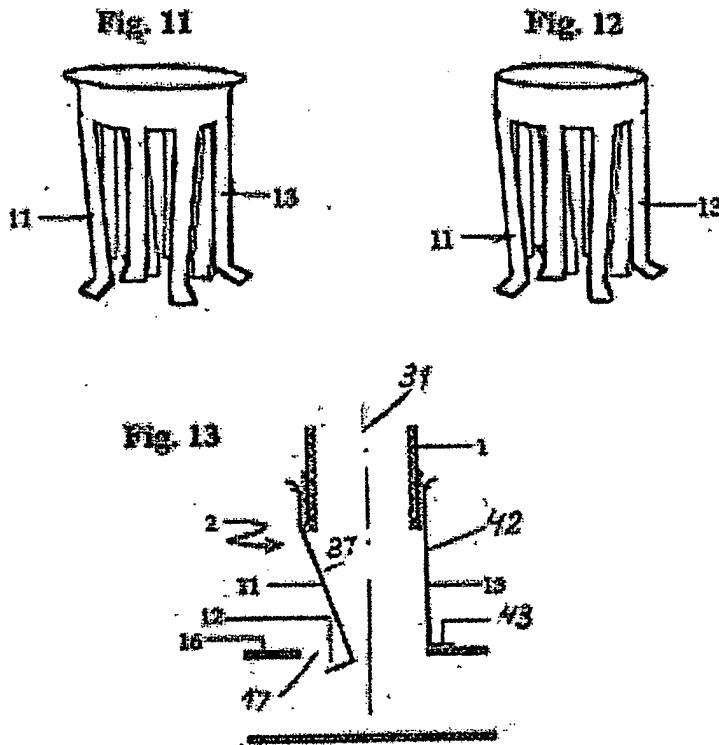
Rejection Under 35 USC §112, First Paragraph

Claims 20-30, 33 and 34 have been rejected under 35 USC §112, first paragraph as failing to comply with the written description requirement. This rejection is respectfully traversed.

At paragraph 2 the Official Action asserts "Applicant claims that the fingers are of uniform radial thickness. However, the radial direction the thickness of the fingers at the gripping portion (12) will be longer since this element is slanted. In the fully extended configuration, the radial thickness of the portion (12) will be the longer dimension of 12."

However, claim 20 has been amended to remove the "radial" limitation so as to recite "said fingers are of uniform thickness," which removes any issues about the thickness in regards to the orientation of the gripping portion 12. As such, the term "thickness" should be interpreted in a conventional manner when considering the length, width and thickness of the fingers.

Also, the drawing figures of the application clearly show a uniform thickness of the main portion 11 and the gripping portion 12, as is shown by way of example in Figures 11-13, which are reproduced below.



The term "thickness" thus refers to the cross-sectional dimension of the finger, including both its main portion 11 and its gripping portion 12, perpendicular to the surface of the finger. Thus its radial thickness will not be a function of the position of the position of the finger, contrary to the impression given by the Official Action.

According to the Official Action, the recitation that the fingers are uniformly thick is not supported by the

specifications or drawing figures, and hence represents new matter.

However, the Official Action itself concedes that the fingers do have uniform thickness in the drawing figures included in the patent application. Indeed, care was taken to ensure that in every drawing figure in which the fingers were represented in cross-section (Figures 6, 10, 13, 17-19, 26-29, and 32-35), their thickness was uniform. Consistency in illustration will be interpreted by any practitioner skilled in the art as an unambiguous definition of a geometric characteristic, and making a statement on the thickness of the fingers in the specifications redundant.

Further, at paragraph 3 the Official Action asserts: "Although the cross section shows the finger is relatively the same thickness where the cross-section was taken, this doesn't mean that each of the fingers could not be thicker at locations circumferentially offset of the place where the cross section was taken."

Nonetheless, even if *arguendo* there could be other thicknesses, the applicant is still entitled to claim uniform thicknesses from among these thicknesses.

United States case law points out the specification need not describe the claimed invention in *ipsis verbis* to comply with the written description requirement. *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978). The test is whether the originally

filed specification disclosure reasonably conveys to a person having ordinary skill that applicant had possession of the subject matter later claimed. *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983). Also, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the applicants specification disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

As a result, the claims are in full compliance with the written description requirement, and no new matter has been added to the application.

This rejection is believed to be overcome, and withdrawal thereof is respectfully requested.

**Rejection Under 35 USC §112, Second Paragraph**

Claim 30 has been rejected under 35 USC §112, second paragraph as being indefinite. This rejection is respectfully traversed.

The Official Action asserts that claim 30 contains indefinite terminology. The comments in the Official Action have been considered, and claim 30 has been amended to be clear, definite and have full antecedent basis.

This rejection is believed to be overcome, and withdrawal thereof is respectfully requested.

Rejections Based on BLOOMER

Claims 20-25, 30, and 33-35 have been rejected under 35 USC §102(b) as being anticipated by BLOOMER (U.S. Patent 2,537,183). Claim 26 has been rejected under 35 USC §103(a) as being unpatentable over BLOOMER in view of HART (U.S. Patent 1,339,620). Claim 27 has been rejected under 35 USC §103(a) as being unpatentable over BLOOMER in view of DEFAUW (U.S. Patent 3,358,357). Claim 28 has been rejected under 35 USC §103(a) as being unpatentable over BLOOMER in view of HAURY (U.S. Patent 2,211,776). Claim 29 has been rejected under 35 USC §103(a) as being unpatentable over BLOOMER in view of FROST (U.S. Patent 3,228,713). These rejections are respectfully traversed.

The present invention pertains to a connecting device having a first element 1 and a second element 2 that is shown, by way of example, in Figures 7 and 8 of the application, reproduced below.

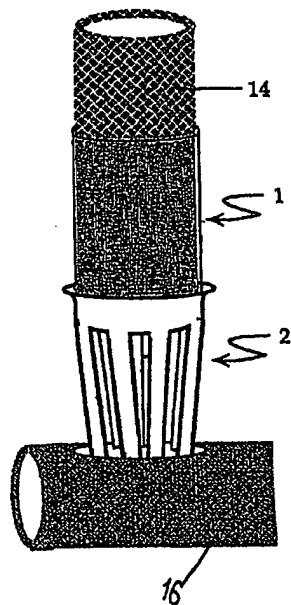


Fig. 7

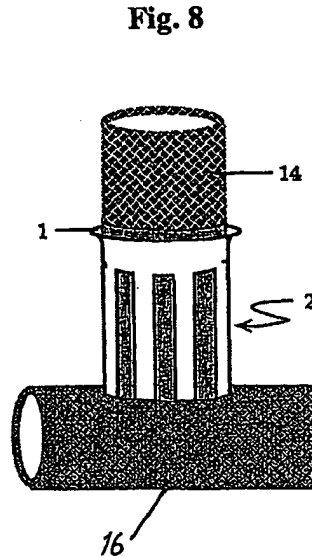
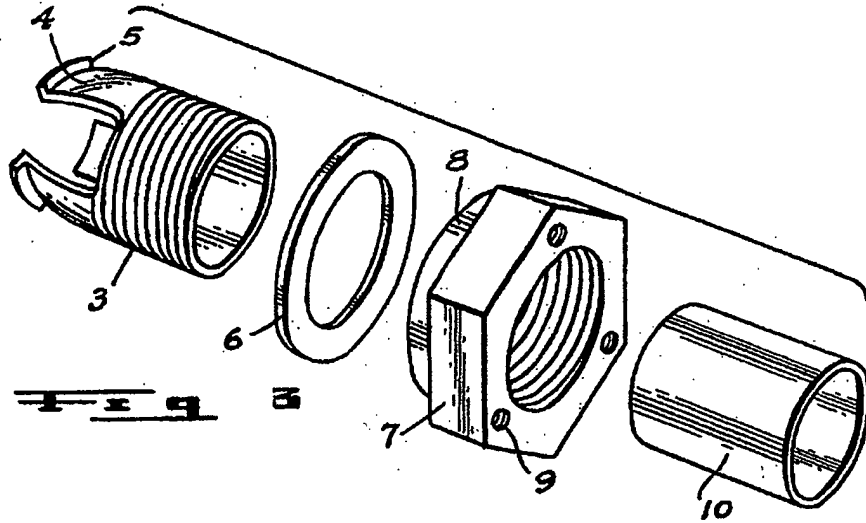


Fig. 8

The second element is provided with at least two elongated first fingers which are arranged at intervals along the circumference of the first passage, and the fingers are of uniform radial thickness. Each of the fingers is formed from a main portion extending from a second front portion and in the direction of a second longitudinal axis, and the main portion is continuous with a gripping part, wherein the gripping part is directed away from the second longitudinal axis in an undeformed condition of said second element, such that introduction of the first element into the second element displaces the main portions of the fingers radially outwards. See claim 20.

BLOOMER pertains to a coupling connection having a third element, including a threaded tubing having one end formed

with an inwardly curving reduced internal diameter. See claim 1 and Figure 3 of BLOOMER, reproduced below.



BLOOMER includes a third element, a nut 7, receivable on the threads of the first element (claim 1, column 3, line 48, claim 2, column 3, line 57, claim 3, column 4, line 10, claim 4, column 4, line 23, claim 5, column 4, line 39). In contrast, the present invention includes only two elements as clearly stated in claim 1.

That is, the present invention has a second element that does not incorporate threads. The device of claim 1 of the present invention is composed of only two elements.

Also, even "if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference." That there is no ambiguity in this interpretation of 35 USC § 102 has been

confirmed in *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999).

Additionally, omission of an element and retention of its function is an indicia of patentability. *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966) (Claims at issue were directed to a printed sheet having a thin layer of erasable metal bonded directly to the sheet wherein said thin layer obscured the original print until removal by erasure. The prior art disclosed a similar printed sheet which further comprised an intermediate transparent and erasure-proof protecting layer which prevented erasure of the printing when the top layer was erased. The claims were found patentable over the prior art because although the transparent layer of the prior art was eliminated, the function of the transparent layer was retained since appellant's metal layer could be erased without erasing the printed indicia.).

On the other hand, the case law cited in the Official Action in this context (*Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004), *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) is not germane to the issue, because it is the prior art (BLOOMER) that includes additional elements and not the applicant's invention.

That is, BLOOMER unambiguously states that the first element 10 is threaded (claim 1, column 3, line 43, claim 2,



column 3, line 54, claim 3, column 4, line 4, claim 4, column 4, line 17, claim 5, column 4, line 33).

In contrast, in the present invention, the corresponding structure, the second element 2, does not incorporate such a limitation. The case for equivalence between structure 10 of BLOOMER's patent and structure 2 of the present invention made by the Official Action does not hold up under scrutiny, because "the accused device must contain at least an equivalent for each limitation" (*Pennwalt Corp v Durand-Wayland Inc*, 833 F2d 931 (Fed. Cir. 1987)). Further as was clarified in *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958), "equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure."

BLOOMER thus fails to anticipate claim 20 of the present invention. Claims depending upon claim 20 are patentable for at least the above reasons.

BLOOMER additionally fails to be usable as the basis or an assertion of *prima facie* unpatentability.

The present invention is designed for joining ("anastomosing") tubular structures in a living organism, while BLOOMER specifically states that the object of his invention is connection to "various types of containers and castings" (column 1, line 3). HART's invention represents a "coupler for connecting two sections of a hose (column 1, line 11). DEFAUW describes a "novel procedure for fixing a plastic collar or grommet in the

orifice used for filling or emptying (a) vessel" (columns 1, line 21). FROST's invention was designed to "(connect) the ends of pipe ... (or) ... end or ends of a relatively smooth, elastic hose" (column 1, line 18), while the coupling described by HAURY was for tubing, and more particularly to coupling for metallic tubing which is subject to exceptional vibration during use (column 1, line 1).

One of ordinary skill in the art would recognize that BLOOMER's technology, alone or combined with cited prior art, cannot be used for joining tubular organs *in vivo*. That BLOOMERS's invention has not found use as an implant for anastomosing organs, despite being in the public domain for over 50 years, is eloquent testimony to its status as non-analogous art. The present invention, on the other hand, has already been reduced to practice in the laboratory. For determining obviousness, "it is the invention as a whole that must be considered ..., and the invention as a whole includes the problem it solves." See, e.g., *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed.Cir.1985). The problem an invention solves must necessarily be taken into consideration in the evaluation of an invention and putative prior art. *In re Rinehart*, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976): "the particular problem facing the inventor must be considered in determining obviousness". The applicant's invention and the prior art "(faced) different problems requiring different

solutions." *In re Benno*, 768 F.2d 1340, 1346, 226 USPQ 683, 687 (Fed.Cir.1985). As reiterated in *In re Wright*, 6 UUSPQ 2d 1959 (1988), "the problem solved by the invention is always relevant. The entirety of a claimed invention, including the combination viewed as a whole, the elements thereof, and the properties and purpose of the invention, must be considered".

One of ordinary skill and creativity would thus fail to produce a claimed embodiment of the present invention from a knowledge of BLOOMER and the secondary references. A *prima facie* case of unpatentability has thus not been made.

These rejections are believed to be overcome, and withdrawal thereof is respectfully requested.

#### Conclusion

Prior art of record but not utilized is believed to be non-pertinent to the instant claims.


It is believed that the rejections have been overcome, obviated or rendered moot, and that no issues remain. The Examiner is accordingly respectfully requested to place the application in condition for allowance and to issue a Notice of Allowability.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

overpayment to Deposit Account No. 25-0120 for any additional  
fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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